

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

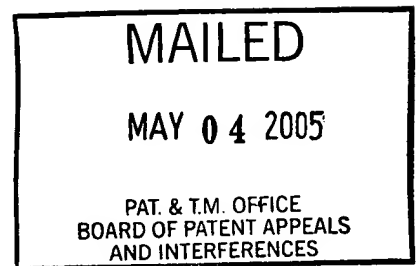
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GENE KELLY NORRIS

Appeal No. 2005-0846
Application No. 09/981,339

ON BRIEF



Before CAROFF, TIMM, and PAWLIKOWSKI, Administrative Patent Judges.

CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6, and 9-35, all the claims now pending in appellant's application.

The appealed claims are directed to a polymer composition normally susceptible to heat-induced decomposition which includes a halogen-containing polymer; and to a stabilizer composition,

1. A polymer composition normally susceptible to heat-induced decomposition comprising a halogen-containing polymer, the degradation products of a blocked mercaptan present during processing of the composition at an elevated temperature, said products including a free mercaptan; said blocked mercaptan having the structure:



wherein a is 0 or 1, m and n are 0 or 1; y = 1 to 4; when y = 1, z is 1 to 4; and when y is more than 1, z is 1; R¹ is an alkyl, alkylenyl, cycloalkyl, cycloalkylenyl, aryl, alkaryl, aralkyl, aralkylenyl, hydroxyalkyl, dihydroxyalkyl, hydroxy(polyalkoxy)alkyl, alkoxyalkyl, hydroxyalkoxyalkyl, alkoxy(hydroxyalkyl), alkoxy(acyloxyalkyl), alkoxy(polyalkoxy)alkyl, alkoxy(polyalkoxy)carbonylalkyl, carboxyalkyl, acyloxyalkyl, acyloxy(hydroxyalkyl), acyloxyalkoxyalkyl, acyloxy(polyalkoxy)alkyl, benzoyloxy(polyalkoxy)alkyl, alkylenebis-(acyloxyalkyl), alkoxycarbonylalkyl, alkoxycarbonylalkylenyl, hydroxyalkoxycarbonylalkyl, hydroxy(polyalkoxy)carbonylalkyl, mercaptoalkyl, mercaptoalkylenyl, mercaptoalkoxycarbonylalkyl, mercaptoalkoxycarbonylalkylenyl, alkoxycarbonyl(amido)alkyl, alkylcarbonyloxy(polyalkoxy)carbonylalkyl, tetrahydropyranyloxy(polyalkoxy)carbonylalkyl, tetrahydropyranyloxyalkyl, hydroxyaryl, mercaptoaryl or carboxyaryl radical having from 1 to 22 carbon atoms; R², R³, R⁴, R⁵, R⁶, and R⁷ are independently hydrogen, a hydroxyl, mercapto, acyl, alkyl, alkylenyl, aryl, haloaryl, alkaryl, aralkyl, hydroxyalkyl, mercaptoalkyl, hydroxyaryl, alkoxyaryl, alkoxyhydroxyaryl, mercaptoaryl groups having from 1 to 22 carbon atoms; X is aryl, haloaryl, alkaryl, hydroxyaryl, dihydroxyaryl, alkoxyaryl, arylcycloalkyl, or a heteroatom, with the option that when a is 1 and m is 1, R⁶ and R⁷ form a heterocyclic moiety in conjunction with X as nitrogen, and with the further option that when a = 1 and m = 0, one of R¹, R³, and R⁵ joins with R⁷ and X to form a heterocyclic moiety with X as a heteroatom selected from the group consisting of oxygen and sulfur; with the proviso that z is 1 or 2 when X is aralkaryl, R⁶ and R⁷ are hydroxyl, a is 1 and m is 1, and with the further proviso that when R⁶ ≠ hydroxyl or mercapto, z is 1;

from greater than 0.5 to about 2 phr of a mixture of zinc chloride and a zinc carboxylate; and

from 0 to about 10 phr of at least one co-stabilizer selected from the group consisting of an epoxy compound and an organic phosphite; all based on the weight of the polymer.

Appeal No. 2005-0846
Application No. 09/981,339

The prior art references relied upon by the examiner
are:

Conroy et al. (Conroy)	6,232,380 B1	May 15, 2001
	(filing date: Nov. 25, 1998)	
Duvall et al. (Duvall)	6,528,566 B2	Mar. 4, 2003
	(filing date: Aug. 13, 1998)	
Duvall et al. (Duvall)	EP 0 890 608 A2	Jan. 13, 1999
(published European Patent Office Patent Application)		

The following rejections are before us for review:

1. Claim 35 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement of the statute.

2. Claims 1-6 and 9-35 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Conroy or, in the alternative, under 35 U.S.C. § 103(a) as being obvious from Conroy.

3. Claims 1-18 and 35 stand rejected under 35 U.S.C. § 103(a) for obviousness in view of Duvall 6,528,566 (hereafter Duvall) or Duvall EP 890 608 (hereafter EP).

We have carefully evaluated the entire record in light of the opposing positions taken by the appellant and the examiner. Having done so, we shall affirm the rejection of claim 35 based upon 35 U.S.C. § 112, first paragraph. Additionally, we shall affirm the rejection of claims 1-6 and 9-35 as being anticipated or, in the alternative, as being obvious from Conroy. Also, with

Appeal No. 2005-0846
Application No. 09/981,339

regard to the rejection based upon Duvall or EP, we conclude that the examiner has established a prima facie case of obviousness which is not outweighed by evidence of nonobviousness relied upon by the appellant.

The specific basis for our conclusion with regard to each rejection is as follows:

REJECTION (1)

We affirm the rejection of claim 35 under 35 U.S.C. § 112, first paragraph, for failure to comply with the written description requirement.

The question in dispute is whether the disclosure in appellant's specification of a stabilizer composition with a mixture of zinc compounds in the range of "from about 0.5 to about 75%" supports the narrower range recited in claim 35 of "from greater than about 12.5 wt % to 75 wt %," within the context of the first paragraph of 35 U.S.C. § 112. Appellant concedes that the lower limit of the narrower range, i.e., "greater than about 12.5 wt %," was not explicitly disclosed in the original specification and claims.

To support the proposition that the original disclosure of a broader range may support the recitation of a narrower range, even though the narrower range had not been explicitly disclosed,

appellant cites, inter alia, In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), and In re Blaser, 556 F.2d 534, 194 USPQ 122 (CCPA 1977). However, as noted in Wertheim, 541 F.2d at 262-3, 191 USPQ at 96-7, determination of questions relating to the written description requirement depend upon the facts of each particular case. There are no hard and fast per se rules in this area. Mere comparison of ranges is not enough.

While it is certainly true that the examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention as defined by the claims, here the examiner has made a finding that appellant's specification gives no indication that a stabilizer was ever tested at concentration limits even close to the claimed lower limit (examiner's answer: sentence bridging pages 5-6). Appellant has failed to provide any rebuttal to the examiner's finding. In this regard, it is to be noted that the fact situation here differs from those in Wertheim and Blaser where, in each case, a specific embodiment or example was presented in the original disclosure close to the claimed lower limit of solids content and temperature, respectively.

Wertheim, 541 F.2d at 265, 191 USPQ at 98; Blaser, 556 F.2d at 538, 194 USPQ at 125.¹

REJECTION (2)

The rejection of all appealed claims under 35 U.S.C. § 102(e) or, in the alternative, under 35 U.S.C. § 103(a) in view of Conroy is affirmed.

Conroy discloses a stabilizer composition for halogen - containing polymers essentially as claimed,² including a latent (blocked) mercaptan, a metal-based stabilizer (e.g., a zinc

¹Another relevant consideration relates to appellant's purpose for claiming a concentration range narrower than originally disclosed. For if the range was narrowed to create a patentable distinction over the prior art based upon a showing of unexpected results within the narrower range, then the question arises whether persons skilled in the art would recognize from the disclosure of a broader range that appellant had possession, as of the filing date of his application, of the patentably distinct invention defined by the narrower range.

As stated in Wertheim, 541 F.2d at 265, 191 USPQ at 98, where it is clear that the broad described range pertains to a different invention than the narrower claimed range, then the broader range does not describe the narrower range.

Since this particular question has not been explicitly raised on appeal, and since the examiner has satisfied his initial burden for establishing a lack of descriptive support, as discussed supra, we find it unnecessary to resolve the question discussed in this footnote.

²Appellant's brief (page 8) stipulates that all of appellant's dependent claims stand or fall with the independent claims for purposes of this appeal. Accordingly, we shall focus our consideration on the three independent claims.

carboxylate such as zinc stearate or zinc laurate), and a Lewis acid (e.g., zinc chloride). The metal-based stabilizer may be present in amounts from about .01 to about 10% by weight of the resin. The Lewis acid may be present in amounts from about .005 to .5% by weight of the resin. Conroy: col. 18, ll. 4-28; col. 19, l. 60-col. 20, l. 5. Thus, the Conroy disclosure embraces appellant's claimed subject matter.

We agree with the examiner that the appealed claims are anticipated by the Conroy disclosure and, in addition, it is axiomatic that anticipation is the epitome of obviousness.

Appellant's primary argument in rebuttal was that Conroy does not constitute prior art under 35 U.S.C. § 102(e) because one of the three named inventors listed on the Conroy reference is also listed as sole inventor with regard to the instant application. According to appellant, this means that the Conroy patent was not granted on an application "by another" as required by 35 U.S.C. § 102(e).

This argument is unpersuasive since, as correctly pointed out by the examiner, it is well established that a different inventive entity constitutes "another" for purposes of the statute even if some, but not all, of the inventors are common to

the reference application and the application under review. Accordingly, Conroy is a valid prior art reference for purposes of this appeal.

In his reply brief, appellant attempts to distinguish his claims from Conroy by arguing that the stabilizer blend of Conroy is limited to protecting only clear halogen-containing polymer compositions. This argument is also of little merit since the instant claims read on stabilizer compositions used to protect clear halogen-containing polymer compositions. Also, the instant claims do not preclude the addition of other compounds, such as the phenyl salicylate of Conroy.

Moreover, in our opinion, the Conroy disclosure is not as limited as appellant makes it out to be. For instance, while Conroy (col. 4, ll. 27-30) indicates that no benefits in terms of ultraviolet light stability and weatherability have been observed as to opaque resin formulations, this says nothing with regard to the benefits expected in terms of heat stability. Also, although Conroy (col. 20, ll. 28-30) states that the disclosed invention is "generally" limited to clear formulations, the term "generally" is ordinarily not interpreted as having an exclusive connotation. Furthermore, at least some of the articles of manufacture contemplated as being within the ambit of the

Appeal No. 2005-0846
Application No. 09/981,339

invention of Conroy (col. 25, ll. 53-55) are ordinarily opaque, e.g., siding, roofing, door striping, etc. Thus, it would not appear that the invention disclosed by Conroy is limited exclusively to use with clear resin formulations.

REJECTION (3)

This rejection is also affirmed.

Duvall and EP each disclose stabilizer compositions much like those of Conroy for halogen-containing polymers, including a latent (blocked) mercaptan, a metal-based stabilizer (e.g., a zinc carboxylate such as zinc stearate or zinc laurate), and a Lewis acid (e.g., zinc chloride). The metal-based stabilizer may be present in amounts from about .01 to less than .5 %. The Lewis acid may be present in amounts from .005 to less than .5%. All the percentages are by weight of the resin. Clearly, the total percentage of the metal-based stabilizer and the Lewis acid may exceed .5%, when used in combination as suggested in Duvall (col. 10, ll. 34-36) as well as in EP (p. 9, ll. 46-7).

We agree with the examiner that it would have been prima facie obvious, within the purview of 35 U.S.C. § 103, to select any of the Lewis acids disclosed in Duvall or EP, such as zinc chloride, to be used in combination with one of the preferred metal-based stabilizers, such as a zinc carboxylate, absent a

showing of any new or unexpected result. Clearly, as noted above, Duvall and EP both contemplate the combination of a Lewis acid with a metal-based stabilizer where the total percentage of both components by weight of the resin may exceed .5%. For instance, the references allow for using percentages approaching .5% for each of these components. Thus, the total percentage for the combination may approach 1.0%.

Appellant relies upon results displayed in Exhibits A and B to demonstrate an improvement in the "early color" appearance of a polymer chip containing a mixture of zinc chloride and zinc laurate when the mixture is used in amounts exceeding .5 phr (%).

We agree with the examiner that the evidence relied upon by appellant is unpersuasive because the improvement in "early color" appearance is demonstrated only at .75% and higher concentrations of the combined zinc compounds. Thus, the evidence of enhanced results is not commensurate with the scope of appellant's claims which encompass lower concentrations, i.e., "greater than .5" phr (claim 1) encompasses .51%, .6%, .7%, etc.

Appeal No. 2005-0846
Application No. 09/981,339

Additionally, the results relied upon by appellant are limited to a comparison using zinc chloride and only one particular zinc carboxylate (zinc laurate). The instant claims are not limited to use of zinc laurate. Accordingly, the evidence is of little probative value as to zinc carboxylates other than zinc laurate.

For the foregoing reasons, the decision of the examiner is affirmed.

Appeal No. 2005-0846
Application No. 09/981,339

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. and TM Office 21 (September 7, 2004)).

AFFIRMED

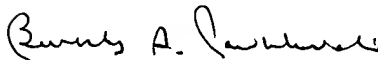


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Administrative Patent Judge)



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BOARD OF PATENT
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Appeal No. 2005-0846
Application No. 09/981,339

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